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OFFICE OF PETITIONS

In re Application of	:	
McAdams	:	
Application No. 09/921,841	:	DECISION ON PETITION
Filing Date: 2 August, 2001	:	
Attorney Docket No. BEA920010012US1	:	

This is a decision on the petition filed on 25 October, 2005, to revive the instant application alternatively under 37 C.F.R. §1.137(a) as having been abandoned due to unavoidable delay or 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

For the reasons set forth below, the petition under 37 C.F.R. §1.137(a) is **DISMISSED**, and the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the final Office action mailed on 19 October, 2004, with reply due absent extension of time on or before 19 January, 2005;
- on 15 December, 2004, Petitioner filed an after-final amendment, which the Examiner found was not a proper reply (in that it did not *prima facie* place the application in condition for allowance¹), and on 29 March, 2005, the Examiner mailed an Advisory Action;

¹ A proper reply is a an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or RCE (with fee and submission). (See: MPEP §711.03(c).)

- Petitioner avers that he filed a further after-final on 19 April, 2005, however, the clear indication is that despite the Certificate of FAX Transmittal indicating such a date, the clear evidence on the face of the filing is a FAX date of 20 April, 2005—moreover, the Examiner found that this amendment, too, was not a proper reply,² and, on 30 September, 2005, the Examiner mailed an Advisory Action and it does not appear that Petitioner had requested and paid the fee for an extension of time;
- Petitioner alleges that he had an expectation of a new final rejection, however, as one registered to practice before the Office Petitioner is well aware that no after-final amendment is as of right;
- with the instant petitions, Petitioner submits the respective fees, and a reply in the form of a request for continued examination (RCE) under 37 C.F.R. §1.114 with fee and submission, however—while Petitioner has made the statement of unintentional delay under 37 C.F.R. §1.137(b)—the showing of unavoidable delay under 37 C.F.R. §1.137(a) is, as indicated above, wholly insufficient.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).³

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁴

² The proper response to the final Office action (see: MPEP 711.03(c)) must be in the form of: (a) an amendment *prima facie* placing the application in condition for allowance; (b) a Notice of Appeal; or (c) a Request for Continued Examination (RCE) (with fee and submission) under 37 C.F.R. §1.114.

³ 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁴ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

Delays in responding properly raise the question whether delays are unavoidable.⁵ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁶ And the Petitioner must be diligent in attending to the matter.⁷ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁸))

Allegation as to Unavoidable Delay

A grantable petition under 37 C.F.R. §1.137(a) requires a petition, fee, showing of unintentional delay to the satisfaction of the Director, reply, and a terminal disclaimer and fee if appropriate.

As indicated above, Petitioner has not satisfied the showing requirement of the regulation.

Allegations as to Unintentional Delay

A grantable petition under 37 C.F.R. §1.137(b) requires a petition, fee, statement of unintentional delay, reply, and a terminal disclaimer and fee if appropriate.

As indicated above, Petitioner has provided a petition, fee, reply and statement as required by regulation.

CONCLUSION

The petition under 37 C.F.R. §1.137(a) is **dismissed**, and the petition under 37 C.F.R. §1.137(b) is **granted**.

⁵ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

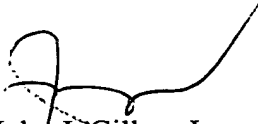
⁶ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁷ See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

⁸ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

The instant application is released to Technology Center 2100 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to read 'John J. Gillon, Jr.', with a stylized flourish extending from the end.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions